

ATTORNEY DOCKET NO. 2002832-0016

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3716

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sosin
Serial No.: 09/996,461
Filing Date: November 28, 2001
Title: IMPACT AND ROLL MEASUREMENT DEVICE

Examiner: Legesse
Art Unit: 3711

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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March 24, 2005	<i>Kathy Hart Lyon</i>
Date	Signature
KATHY HART LYON	
Typed or Printed Name of person signing certificate	

Sir:

TRANSMITTAL

Enclosed please find the following documents regarding the above-referenced matter:

- 1) Request to Withdraw Finality of Office Action (2 pp.)
- 2) Return postcard.

Please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully Submitted,
CHOATE, HALL & STEWART

Date: March 24, 2005

C. Lyon

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Sir:

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

Applicant hereby requests that the finality of the Office Action mailed March 10, 2005, in the above-referenced case be withdrawn. As described below, the finality of the Office Action is premature.

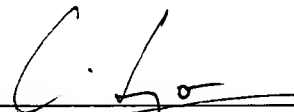
Applicant filed a Request for Continued Examination (RCE) on June 4, 2004. A first Office Action was mailed on July 13, 2004 that included prior art rejections over U.S. Patent Nos. 4,681,791 and 5,394,824. Applicant responded to these rejections on November 15, 2004 and they were withdrawn in the second Office Action mailed March 10, 2005. The only rejection in this second Office Action is based on newly cited reference U.S. Patent No. 6,514,446. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims*" (emphasis added). Applicant respectfully submits that the new ground of rejection in this second Office Action was *not* necessitated by any of the claim amendments that applicant made in the response that was filed on November 15, 2004. Indeed, the examiner relies on U.S. Patent No. 6,514,446 in part to reject claims that cover substantially the *same* subject matter as they did at the time of the first Office Action (e.g.,

claims 20-24). Thus, the examiner could have relied upon U.S. Patent No. 6,514,446 in the first Office Action.

As noted in MPEP §706.07, “before final rejection is in order a clear issue should be developed between the examiner and applicant” and “switching [...] from one set of references to another by the examiner in rejecting in successive actions *claims of substantially the same subject-matter*, will [...] tend to defeat attaining the goal of reaching a clearly defined issue for an early termination” (emphasis added).

Applicant respectfully submits that no clear issue has yet arisen in this case because the examiner has simply switched from one set of references to another in order to reject claims of substantially the same subject-matter. In light of these facts, applicant respectfully requests that the finality of the second Office Action be removed. Please charge any fees associated with this filing, or apply any credits, to our Deposit Account No. 03-1721.

Respectfully submitted,



Charles E. Lyon, D.Phil.
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